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6 Attorney for Plaintiff

ADR

8 UNITED STATES DISTRICT COURT
9 NORTHERN DISTRICT OF CALIFORNIA

10
11 BONNIE STERNGOLD,

12 Plaintiff,

13 vs.

14 ANTHONY ROBERTS, DOES 1-10,

15 Defendant

) Case No.: C07-02450

) COMPLAINT FOR TRADEMARK

) INFRINGEMENT UNDER 15 U.S.C. §
1051 et seq.

BY FAX

16
17 Plaintiff-Bonnie-Sterngold (hereinafter, "Plaintiff"), by and
18 through its undersigned counsel, for its Complaint against
19 Defendant Anthony Roberts and Does 1-10 (hereinafter,
20 collectively, "Defendants") states the following. Allegations
21 made on belief are premised on the belief that the same are
22 likely to have evidentiary support after a reasonable
23 opportunity for further investigation and discovery.

24
25 THE PARTIES

26
27 1. Plaintiff Bonnie Sterngold is an individual having a
28 mailing address at 15 Peak Lane, Portola Valley, CA 94028.

ORIGINAL
FILED
MAY - 7 2007
RICHARD W. WIEKING
CLERK U.S. DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
OAKLAND

EMC

2. Upon information and belief, Defendant Anthony Roberts is an individual having a mailing address at 820 S Washington St., Diamond, MO 64840.

NATURE OF ACTION

3. This is an action for trademark infringement and false designation of origin under the Trademark Act of 1946, as amended (The Lanham Act, 15 U.S.C. § 1051 et seq.), trademark dilution under Section 14430 of the Business and Professions Code of the State of California, and unfair competition under the common law and Section 17200 of the Business and Professions Code of the State of California, based on the Defendant's adoption and use of "Stirling" as a brand name for sharpeners in violation of Plaintiff's established rights in "Sterling" as a registered trademark for sharpeners.

JURISDICTION AND VENUE

4. This Court has jurisdiction over this action pursuant to 15 U.S.C. § 1121 (actions arising under the Federal Trademark Act), 28 U.S.C. 1338(a) (acts of Congress relating to trademarks), 28 U.S.C. 1338(b) (pendent unfair competition claims). Venue is proper in this District pursuant to 28 U.S.C. 1391(b).

COUNT ONE

INFRINGEMENT OF FEDERAL TRADEMARK REGISTRATION NO. 2311151

1 5. Plaintiff hereby realleges and incorporates by reference
2 the allegations of paragraphs 1 through 5 of this Complaint as
3 if fully set forth herein.
4

5 6. Plaintiff is the owner of United States Trademark
6 Registration No. 2311151, registered January 25, 2000, for
7 "Sterling" (for hand tools, namely knife sharpeners in Class
8 008) a certified copy of which is attached hereto as Exhibit A.
9 This registration is now valid, subsisting, uncanceled and
10 unrevoked.
11

12 7. Continuously since on or about August 12, 1992, Plaintiff
13 has used its "Sterling" mark in connection with and to identify
14 its sharpeners and to distinguish said products from similar
15 products offered by other companies, by, and without limitation,
16 prominently displaying said mark on sharpeners and advertising
17 and promotional materials distributed throughout the United
18 States. Plaintiff's products sold under the "Sterling" mark and
19 brand name are provided nationwide including in the State of
20 California.
21

22 8. In addition, as of the date of the filing of this
23 complaint, Plaintiff is actively engaged in expanding its use of
24 the "Sterling" in connection with sharpeners in interstate
25 commerce throughout the United States including in the State of
26 California.
27
28

1 9. Defendants have infringed Plaintiff's mark in interstate
2 commerce by various acts, including, without limitation, the
3 selling, offering for sale, promotion and advertising sharpeners
4 under the name "Stirling" of a type virtually identical to the
5 type of sharpeners offered by Plaintiff, prominently displaying,
6 advertising, and promoting sharpeners under the name "Stirling."

7
8 10. Defendant's use of "Stirling" in connection with sharpeners
9 is without permission or authority of the Plaintiff and said use
10 is likely to cause confusion, to cause mistake and/or to
11 deceive.

12
13 11. Defendant's use of "Stirling" in connection with sharpening
14 products has been made notwithstanding Plaintiff's well-known
15 and prior established rights in the trademark "Sterling" and
16 with both actual and constructive notice of Plaintiff's federal
17 registration rights under 15 U.S.C. § 1072.

18
19 12. Upon information and belief, Defendant's infringing
20 activities have caused and, unless enjoined by this Court, will
21 continue to cause, irreparable injury and other damage to
22 Plaintiff's business, reputation and good will in its federally
23 registered "Sterling" trademark. Plaintiff has no adequate
24 remedy at law.

25
26 **COUNT TWO**

27 **FALSE DESIGNATION OF ORIGIN**

28 **UNDER 15 U.S.C. § 1125(A)**

13. Plaintiff hereby realleges and incorporates by reference the allegations of paragraphs 1-12 of this Complaint as if fully set forth herein.

14. Upon information and belief, Defendant has used the designation "Stirling" in connection with sharpening products in interstate commerce. Said use of the designation "Stirling" is a false designation of origin, a false or misleading description and representation of fact which is likely to cause confusion and to cause mistake, and to deceive as to the affiliation, connection or association of Defendant with Plaintiff and as to the origin, sponsorship, or approval of Defendant's products and commercial activities by Plaintiff.

15. Upon information and belief, Defendant's wrongful activities have caused, and unless enjoined by this Court will continue to cause, irreparable injury and other damage to Plaintiff's business, reputation and good will in its "Sterling" mark. Plaintiff has no adequate remedy at law.

COUNT THREE

**COMMON LAW UNFAIR COMPETITION AND
TRADEMARK INFRINGEMENT**

16. Plaintiff realleges and incorporates by reference the allegations of paragraphs 1 through 15 of this Complaint as if fully set forth herein.

1 17. Defendant's activities as stated herein constitute unfair
2 competition and an infringement of Plaintiff's common law
3 trademark rights in the name "Sterling" within the State of
4 California and in violation of California law.

5
6 18. Upon information and belief, Defendant's wrongful and
7 infringing activities have caused, and unless enjoined by this
8 Court will continue to cause, irreparable injury and other
9 damage to Plaintiff's business, reputation and good will in its
10 "Sterling" mark. Plaintiff has no adequate remedy at law.

11
12 **COUNT FOUR**

13 **TRADEMARK DILUTION UNDER CALIFORNIA LAW**
14

15 19. Plaintiff realleges and incorporates by reference the
16 allegations of paragraphs 1-18 of this Complaint as if fully
17 stated herein.

18
19 20. Plaintiff's "Sterling" trademark constitutes a famous mark
20 in the State of California pursuant to Section 14430 of the
21 Business and Professions Code of the State of California which
22 mark became famous prior to the commencement of Defendant's
23 activities as alleged herein.

24
25 21. Upon information and belief, Defendant's activities as
26 alleged herein dilute the distinctive quality of Plaintiff's
27 "Sterling" mark in violation of Section 14430 of the Business
28 and Professions Code of the State of California.

22. Upon information and belief, Defendant's wrongful activities have caused, and unless enjoined by this Court will continue to cause, irreparable injury and other damage to Plaintiff's business, reputation and good will in its "Sterling" mark. Plaintiff has no adequate remedy at law.

COUNT FIVE

VIOLATIONS OF THE CALIFORNIA UNFAIR PRACTICES ACT

23. Plaintiff realleges and incorporates by reference the allegations of paragraphs 1 through 22 of this Complaint as if fully set forth herein.

24. Defendant's activities alleged herein constitute unfair and deceptive acts and practices in the conduct of its trade and business in violation of Section 17200 of the Business and Professions Code of the State of California.

25. Upon information and belief, Defendant's wrongful and deceptive activities have caused, and unless enjoined by this Court will continue to cause, irreparable injury and other damage to Plaintiff's business, reputation and good will in its "Sterling" mark. Plaintiff has no adequate remedy at law.

WHEREFORE, Plaintiff prays:

1. That a preliminary and permanent injunction issue restraining Defendant, its agents, servants, employees, successors and assigns and all others in concert and privity

1 with them from using the name "Stirling" in connection with the
2 offering of sharpeners, from infringement of U.S. Trademark
3 Registration No. 2311151, from unfairly competing with
4 Plaintiff, from engaging in unfair and deceptive trade practices
5 and from injuring Plaintiff's business reputation and diluting
6 its trademark rights, pursuant to Section 34 of the Lanham Act
7 (15 U.S.C. § 1116), Section 14340 of the California Business and
8 Professions Code, and the equitable power of this Court to
9 enforce the common law of the State of California.

10
11 2. That Defendant be required to account to Plaintiff for
12 Defendant's profits and the actual damages suffered by Plaintiff
13 as a result of Defendant's acts or infringement, false
14 designation of origin, unfair competition, and unfair and
15 deceptive trade practices, together with interest, and that
16 Plaintiff's recovery be trebled, pursuant to Section 35 of the
17 Lanham Act (15 U.S.C. § 1117), Section 14340 of the California
18 Business and Professions Code, and common law of the State of
19 California.

20
21 3. That Defendant be ordered to surrender for destruction all
22 nameplates, labels, advertisements, and other materials
23 incorporating or reproducing the infringing "Stirling" mark,
24 pursuant to Section 36 of the Lanham Act (15 U.S.C. § 1118),
25 Section 14340 of the California Business and Professions Code,
26 and the equitable power of this Court to enforce the common law
27 of the State of California.

1 4. That Defendant be compelled to pay Plaintiff's attorneys'
2 fees, together with costs of this suit, pursuant to Section 35
3 of the Lanham Act (15 U.S.C. § 1117) and the common law of the
4 State of California.

5
6 5. That Defendant be compelled to pay Plaintiff punitive
7 damages pursuant to Section 3294(a) of the California Civil
8 Code.

9
10 6. For such other and further relief as may be just and
11 equitable.

12
13 Respectfully Submitted,

14 Dated this 4th day of May, 2007


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17 _____
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EXHIBIT A

Int. Cl.: 8

Prior U.S. Cls.: 23, 28 and 44

Reg. No. 2,311,151

United States Patent and Trademark Office

Registered Jan. 25, 2000

**TRADEMARK
PRINCIPAL REGISTER**

STERLING

STERNGOLD, BONNIE (UNITED STATES CITIZEN), DBA STERLING SYSTEMS
15 PEAK LN
PORTOLA VALLEY, CA 34028

FIRST USE 8-12-1992; IN COMMERCE 8-12-1992.

SER. NO. 75-564,751, FILED 10-5-1998.

FOR: HAND TOOLS, NAMELY KNIFE SHARPENERS, IN CLASS 8 (U.S. CLS. 23, 28 AND 44).

SHANETTA PASKEL, EXAMINING ATTORNEY